

***REMARKS***

Applicants respectfully request the Examiner to reconsider the present application in view of the following remarks. Applicants note that no claims are being amended, added or canceled. Thus, a listing of the claims is not necessary.

***Status of the Claims***

In the present application, claims 1-15 are pending. Claims 12-15 have been withdrawn from consideration due to the election of species requirement (see paragraphs A-D of the outstanding Office Action).

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

***Election***

Further to paragraph D, page 4 of the Office Action, Applicants herein confirm their election of Group I, claims 1-14. Applicants also reserve the right to have any further species considered and rejoined by the Examiner once allowable subject matter of the currently elected subject matter is found (see also paragraph B of the Office Action).

***Issues Under 35 U.S.C. § 102***

Claims 1-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Morishima et al. '040 (U.S. Patent No. 54,994,040) (see paragraph F of the Office Action). Applicants

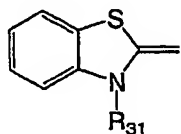
respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

In the Office Action, the Examiner refers Applicants to various parts of the cited Morishima '040 reference. For instance, the Examiner states in the last paragraph on page 5 of the Office Action that:

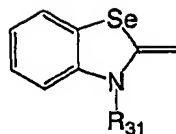
Morishima et al. disclose and teach the chemical structure of the spectrally "Sensitizing Dye-1" being read within the general formula I as claimed but do not specify the property of "dissolved in water . . ." as that in claim 8 . . .

The Examiner also states that Morishima '040 reads upon instantly claimed Formula I of pending claim 1 (see the sentence bridging pages 4-5 of the Office Action). Applicants respectfully disagree regarding what Morishima '040 actually discloses and further submit that Morishima '040 does not disclose all instantly claimed features.

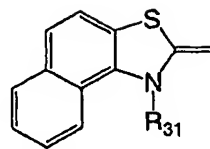
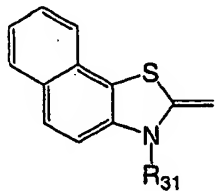
In the present invention and as recited in instantly pending claim 1, the dye of formula I essentially has a benzothiazole ring, benzoselenazole ring, naphthothiazole ring, naphthoselenazole ring or quinoline ring (see page 211, lines 16-17 of claim 1 as shown in Applicants' specification). Thus, the chemical structures of these rings in the present invention that form the left side of formula I of claim 1 are shown below:



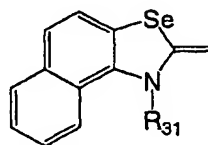
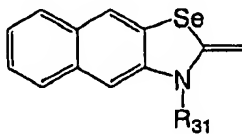
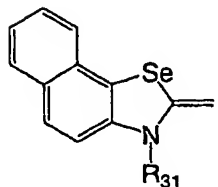
benzothiazole ring



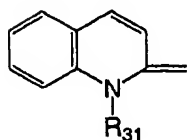
benzotselenazole ring



naphthothiazole ring



naphthoselenazole ring



quinoline ring

Accordingly, upon a comparison of the above ring structures of the present invention, one of ordinary skill in the art would understand that the "Sensitizing Dye-1" as disclosed in columns 211-212 of Morishima '040 has none of the above rings. In addition, the other sensitizing dyes disclosed in Morishima '040 also have none of the above rings of the present invention (see, e.g., the other "Sensitizing Dyes (S-1) to (S-5)" in columns 186, 190 and 192; see also "Sensitizing Dye-2" at columns 211-212). Therefore, Morishima '040 fails to disclose a sensitizing dye

falling within formula I of instantly pending Claim 1 of the present invention, and thus this rejection has been overcome.

This rejection has been overcome because “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, wherein Morishima ‘040 does not disclose the claimed same ring structures, the rejection in view of Morishima ‘040 is overcome. Reconsideration and withdrawal are respectfully requested.

***Issues Under 35 U.S.C. § 103(a)***

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Morishima ‘040 considered in view of Arai ‘907 (U.S. Patent No. 5,876,907) (see paragraph G of the Office Action). Applicants respectfully traverse. Applicants do not concede that a *prima facie* case of obviousness has been established.

As discussed above, the cited primary reference of Morishima ‘040 fails to disclose a sensitizing dye as instantly claimed. Specifically, though the Examiner refers to how Morishima ‘040 discloses Formula I of the present invention, Applicants respectfully submit that the cited Morishima ‘040 reference does not disclose the ring structures of instantly pending claim 1. Further, this lack of disclosure has not been properly accounted for in the Office Action, and Morishima ‘040 fails to disclose or recognize any use of a compound of formula I of the present

invention. Accordingly, Applicants respectfully submit that Morishima '040 fails to disclose all of the instantly claimed features.

Further, the cited secondary reference of Arai '907 does not account for the deficiencies of the primary reference. Instead, Arai '907 is only cited to disclose the use of silver halide grains as shown in the Office Action at page 7, lines 15+. Thus, Applicants respectfully submit that a *prima facie* case of obviousness has not been established, since not even the requirement of disclosure of all claimed features, based on the cited combination of Morishima '040 and Arai '907, has been satisfied. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *see also In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, reconsideration and withdrawal of this rejection under 35 U.S.C. § 103(a) are respectfully requested.

Applicants also submit that the requisite motivation for a *prima facie* case of obviousness is lacking. *In re Vaeck*. Specifically, with regard to the silver bromide content, it is stated in column 96, lines 20-28 of Morishima '040 that:

In the present invention, the silver halide emulsion particularly suitable for a dot-to-dot work light-sensitive material comprises silver halide having a silver chloride content of 90 mol % or more, preferably 95 mol % or more, more specifically, silver chlorobromide or silver chloriodobromide containing from 0 to 10 mol % of silver bromide. If the proportion of silver bromide or silver iodide increases, the safelight safety in a bright room may be worsened or the  $\gamma$  value may be disadvantageously lowered.

Thus, one of ordinary skill in the art would clearly understand that the Morishima '040 disclosure actually teaches away from the instantly claimed silver bromide content of 40-90 mol %. Applicants note that any cited reference (e.g., Morishima '040) used for a rejection

under 35 U.S.C. § 103(a) must be considered in its entirety, *i.e.*, as a whole, including those portions that would lead away from a claimed invention. *See W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In other words, the Morishima '040 reference must be read in its entirety, including the teaching away that using too much silver bromide would be have disadvantages (e.g., the safelight safety in a bright room may be worsened or the  $\gamma$  value may be disadvantageously lowered) when employed in the present invention. Thus, the requisite motivation is lacking.

Also, the cited secondary reference of Arai '907 does not account for or compensate for these deficiencies in Morishima '040. For instance, Arai '907 essentially uses a selenium sensitizing compound or a tellurium sensitizing compound, and thus fails to disclose or suggest using the other sensitizing dye in place of the selenium or tellurium sensitizing compound (see the claim 1 of Arai '907). Therefore, Arai '907 does not disclose a compound falling within the formula I of the present invention. Applicants note that the mere fact that disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. *See, In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) and *In re Imperato*, 179 USPQ 730, 732 (CCPA 1973). That suggestion is lacking here, especially given how each cited reference is so deficient in disclosing what is claimed and neither accounts for the deficiencies of one another.

Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. First, one having ordinary skill in the art, even upon reading Morishima '040 and Arai '907, would not have been motivated to use a sensitizing dye of formula I as

instantly claimed. There is even no disclosure of all claimed features in these references. Further, Morishima '040 discloses that using too much silver bromide, even as instantly claimed, leads to disadvantages. Further, a person having ordinary skill in the art would not have predicted that the sensitizing dyes of formula I of the present invention would lead to the advantageous effects as described in the present specification before the claimed invention was made. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

***Conclusion***

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

**Application No. 10/768,440**

**Docket No.: 2870-0273P**

**Art Unit 1752**

**Reply to Office Action of April 7, 2005**

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: October 7, 2005

Respectfully submitted,

By 

Marc S. Weiner

Registration No.: 32,181

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Rd., Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant